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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/629,492
Filing Date: July 31, 2000
Appellant(s): CHANG ET AL.

Donald R Boys
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 9, 2006 appealing from the Office action mailed July 17, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claim 1 is rejected - appealed in this brief; independent.

Claim 2. Rejected - appealed in this brief; dependent.

Claim 3. Canceled

Claim 4. Rejected - appealed in this brief; dependent.

Claim 5. Rejected - appealed in this brief; dependent.

Claim 6. Rejected - appealed in this brief; dependent.

Claim 7. Rejected - appealed in this brief; dependent.

Claim 8. Canceled

Claim 9. Rejected - appealed in this brief; dependent.

Claim 10. Rejected - appealed in this brief; independent.

Claim 11. Rejected - appealed in this brief; dependent.

Claim 12. Canceled

Claim 13. Rejected - appealed in this brief; dependent.

Claim 14. Rejected - appealed in this brief; dependent.

Claim 15. Rejected - appealed in this brief; dependent.

Claim 16. Rejected - appealed in this brief; dependent.

Claim 17. Rejected - appealed in this brief; dependent.

Claim 18. Rejected - appealed in this brief; dependent.

Claim 19. Rejected - appealed in this brief; dependent.

Claim 20. Rejected - appealed in this brief; dependent.

Claim 21. Rejected - appealed in this brief; dependent.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|--------|
| 6,405,245 | BURSON et al | 6-2002 |
| 6,571,253 | THOMPSON et al. | 5-2003 |

Huang, Guowei, The Java Platform, 1996,

<<http://ei.cs.vt.edu/~wwwbtb/book/chap21/javaplatform.html>>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 4-7, 9-11, 13-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998).

Regarding independent claim 1, Burson et al. discloses a method which includes the use of a browser application to navigate on a network (Internet) (column 4, lines 36-65 of Burson et al.). Burson et al. discloses a method in which processing components (functions) of a PI engine are used to perform tasks automatically, the tasks include navigating to websites, registering with the websites with a username and password which includes form filling (form filling includes searching and parsing the data fields in the form) and providing the user with data from the finished tasks (column 3, lines 15-47, column 4, line 66-column 5, line 21 and column 7, lines 30-67 of Burson

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et al.). Burson et al. discloses a method in which the processing components are integrated into browser functionality (column 4, lines 36-65 of Burson et al.). The PI that is obtained using the PI engine contains additional instructions on how to execute transactions (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions, which include navigation and registration transactions, invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. also discloses a method in which additional procedures necessary to complete a transaction may be contained within the PI store (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate processing components (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

Regarding dependent claim 2, Burson et al. discloses a method which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

Regarding dependent claim 4, Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). It is inherent that a program operated by a computer is in the form of machine-readable instructions.

Regarding dependent claims 5 and 6, Burson et al. discloses a method in which a user can specify what navigation sequences to perform (one or more) (column 4, line 66-column 5, line 21 of Burson et al.)

Regarding dependent claims 7 and 9, Burson et al. discloses a method in which the PI engine can execute on a single processor and multiple processors (column 6, lines 24-65 of Burson et al.).

Regarding independent claim 10, Burson et al. discloses a method in which processing components (functions) of a PI engine are used to perform tasks automatically, the tasks include navigating to websites, registering with the websites with a username and password which includes form filling (form filling includes searching and parsing the data fields in the form) and providing the user with data from the finished tasks (column 3, lines 15-47, column 4, line 66-column 5, line 21 and column 7, lines 30-67 of Burson et al.). Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions, which include navigation and registration transactions, invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is

terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). Burson et al. does not disclose the use machine-readable instructions to operate the control application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a program, such as a control application (PI engine), operated by a computer would be in the form of machine-readable instructions.

Regarding dependent claim 11, Burson et al. discloses a method, which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

Regarding dependent claims 13-16, Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.).

Regarding dependent claims 17 and 18, Burson et al. discloses that automated browser functions include emulating all user input actions during navigation (column 10, lines 4-43 of Burson et al.) Burson et al. does not disclose the use of an API for integration purposes with the different functions. However, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate functions (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

Regarding dependent claim 19, Burson et al. discloses a method in which the functional programs intercept the dialog necessary to navigate (i.e. cookie information) (column 8, lines 4-65 of Burson et al.).

Regarding dependent claim 21, Burson et al. discloses a method in which the information used to fill in the form may be generated automatically (column 6, lines 41-44 of Burson et al.). Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions, which include navigation and registration transactions, invisible to the user (column 7, lines 30-67).

Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998) as applied to claim 18 above, and further in view of Thompson et al. (US Patent Number 6,571,253, filed on April 28, 2000).

Regarding dependent claim 20, Burson et al. does not disclose displaying the data structure in a tree format as part of the search function. However, Thompson et al. discloses a method in which in order to perform a search an HTML document is first broken down into a DOM tree which defines the hierarchal structure of the display of the

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document (column 2, lines 1-65 of Thompson et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching of Thompson et al. with the application of searching of Burson et al. because it would have increased the expressive power for locating the data item of interest.

(10) Response to Argument

Regarding the appellant's arguments on pages 8-9, regarding the use of a browser and browser instances in claims 1 and 10 and whether or not it is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. The appellant argues, "...the external browser used for navigation by the user is the browser application controlled by the API's," however this statement is in direct contradiction with the claims as they are currently written. Claim 1 states, "A software-bundle residing on a server for navigating on a data network on behalf of a user by proxy, comprising: a browser application for navigating on the network," which clearly defines the browser application to be a part of the software-bundle residing on the server. At no point is there any discussion that the browser application is external to the software-bundle, contrary to appellant's arguments. In fact, it is actually impossible to even infer the appellant's argument that the browser is separate from the software bundle because, the claim explicitly states that the browser is a part of the software-bundle which resides exclusively on the server. Claim 10 states, "...providing a

machine-readable set of instructions, by a software-control application for initiating, running, and closing the navigation sequence from a server on the data network; executing an instance of a browser application, the execution resulting from the receipt of the machine-readable set of instructions," which again defines the browser application to be residing on the server. Once again, at no point is there any discussion that the browser application is external to the server, contrary to appellant's arguments.

Claims 1 and 10 require three main parts as claimed, a browser application for navigating on a network, a set of functional programs, and a control application. Burson discloses that a PI engine (control application), which is made up of multiple functional components (a set of functional programs) is used to operate simulated web clients (Browser application instances) (column 7, line 30-column 8, lines 12 of Burson). Burson even states at another point in the disclosure that a general web client is Netscape (column 15, line 66 of Burson), thus clearly showing that when Burson discusses simulated web clients he is clearly discussing simulated browser windows or in other words browser instances (column 7, line 30-column 8, lines 12 of Burson).

Regarding the appellant's arguments on page 9, regarding the searching and parsing for data and/or images in claims 1 and 10 and whether or not it is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. The claims state that it is required to have the ability to perform the tasks including, "...data searching, parsing Web pages." At no point in the claims does it state that the system requires "searching and parsing for data and/or images." Rather it

merely requires that the system be able to perform data search of any kind and be able to parse a web page, the accepted definition of parse in the field of computer science being to analyze the structure of it. Thus, the claim requires the ability to search any form of data and analyze a web page's structure in some way. Burson clearly states that the PI engine controls a navigation process which includes navigating within an information provided until the personal information is found at which point it is captured and presented to the user (column 3, lines 18-21 of Burson). This personal information would be information contained on a website that the user would like to view such as the user's checking account balance that would be found on his bank's web site (column 4, lines 60-65 of Burson). Thus, in the example provided the PI engine would control a navigation process that navigated to a web page for the Bank, parsed the page to search for the specific information relating to the user's checking account balance. It is unclear to the examiner how this explained searching for data, by parsing a web page is any different from the claimed limitations of "...data searching, parsing Web pages."

Regarding the appellant's arguments on page 9, regarding the use of APIs to integrate the functional programs with the browser application in claim 1 and whether or not it is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. The examiner stated that Burson does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an

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application such as a browser to operate in conjunction with separate processing components (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine. In other words, the system of Burson was using Java applets and Java virtual machine to integrate the functional components of the PI engine to the simulated web client (browser application instance) (column 7, line 30-column 8, lines 12 of Burson), however Burson never explicitly states that APIs are use to facilitate this integration. However, it is notoriously well-known that Java APIs are used to provide a standard interface needed to run Java applets and applications (see section starting “Java API” on pages 1, line 13-page 2, line 7 of Huang, Guowei, The Java Platform, provided in the last Office Action as proof that is well known that Java APIs are a required part of Java usage), thus in Burson when Java applets and the Java Virtual Machine are used to integrate the functionality of the required APIs that are necessary to run the applets are used, and thus obviously take part in the integration between the functional components and the simulated web client (browser instance). The claim merely states that APIs are used to integrate the function programs to the browser application, and does not provide any more detail to the differences between the required Java APIs that are well-known when using Java and the APIs of the claimed invention. In fact, in dependent claim 17 the appellant goes on to claim that the specific use of the APIs is to provide extensibility by accessing and utilizing Java based routines, much like the required Java API that was described by Huang. Thus, the rejection remains proper.

Regarding the appellant's arguments on pages 9-10, regarding claims 13-18, the appellant merely repeats that arguments found in earlier claims, thus the responses found above provide the basis for maintaining the rejections of claims 13-18.

Regarding the appellant's arguments on page 10, regarding the functional programs ability including at least one of Web page data parsing, image search, failure detection, and dialog intercept in claim 19 and whether or not it is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. The claim explicitly states, "...wherein the functional programs include at least one of Web page data parsing, image search, failure-detection, and dialog intercept." Based on the claim language "include at least one of" Burson is only required to teach one of the four functions to properly reject the claim. As, stated in a previous response above, in the example provided the PI engine would control a navigation process that navigated to a web page for the Bank, parsed the page to search for the specific information relating to the user's checking account balance. Thus, clearly showing Web page data parsing and properly rejecting the claim. However, the examiner included another one of the functions in his rejection in order to fully show the appellant how the teachings of Burson could be applied to the claims during prosecution. The functional components of Burson use cookies to store the dialog that was used to navigate in order to easily perform the navigation again, thus the functional components intercept the dialog necessary to navigate (i.e. cookie information) (column 8, lines 4-65 of Burson et al.). Thus, the examiner has provided a basis for rejection of two of the four features when

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only one is required, thus even if the examiner's interpretation of one of the two is incorrect the rejection will still stand.

Regarding the appellant's arguments on page 10, regarding the inability to combine the teachings of Thompson et al. (hereinafter Thompson) and Burson because it unclear whether or not the ability to search is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. As, stated in a previous response above, in the example provided the PI engine would control a navigation process that navigated to a web page for the Bank, parsed the page to search for the specific information relating to the user's checking account balance, which clearly shows the ability to perform an automated search for data. Thus, the basis for the appellant's arguments is incorrect and the motivation to combine Burson and Thompson, because it would have increased the expressive power for locating the data item of interest, remains proper.

Regarding the appellant's arguments on page 10, regarding the ability to generate input data required to retrieve a user's personal data in claim 21 and whether or not it is disclosed by Burson et al. (hereinafter Burson), the examiner believes that the rejection is proper based on the fact that the teachings of the reference renders the claimed invention obvious. The appellant states that "...Burson does not teach or suggest generating any input data whatsoever," based on a citation in Burson, column 8, lines 13-32. However, it is important to note that the appellant has excluded the teachings of other disclosed embodiments in making the false assumption that Burson

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does not teach generating the data. In the previous rejection, the examiner clearly stated that Burson discloses a method in which the information used to fill in the form may be generated automatically (column 6, lines 41-44 of Burson). More specifically, Burson states "...preferably configuration by example (executing the protocol in the simulated Web client where the simulated Web client automatically generates a list of required data..." (column 6, line 41-43 of Burson), which clearly shows that Burson does in fact teach the automatic generation of the data necessary to register a user. The appellant does not argue this citation at any point even though is cited as a based for the previous rejection, thus it remains unclear how the appellant's invention as claimed is different from the clearly disclosed teachings of Burson.

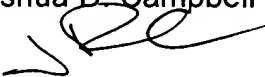
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joshua D. Campbell


STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Conferees:


Stephen Hong, Supervisory Patent Examiner for Group Art Unit 2178

 for
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